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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,894

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Robert M. Soule III

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11/14/2006

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EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/669,894

**Applicant(s)**

SOULE ET AL.

**Examiner**

Uyen-Chau N. Le

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-18, 47-54 and 69-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18, 47-54 and 69-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 10/10/2006.

Applicant's arguments with respect to the rejection(s) of claim(s) 13-18, 47-54 and 69-88 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Knowles et al (US 5869819 A) and Antognini et al (US 6176427 B1). This Office Action is therefore made NON-FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Knowles et al (US 5869819 A).

Re claim 13: Knowles et al discloses a symbol generator including: a graphical user interface (col. 13, lines 23-25) including a first data input area facilitating entry of a

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designator for a formatted file (i.e., Block A) (fig. 7A; col. 15, lines 6-10), and a second data input area facilitating entry of command data (i.e., Block D); an encoder encoding into at least one symbol a formatted file in accordance with the designator, and a command in accordance with the input command data (fig. 7A; col. 15, line 62 through col. 16, line 7).

4. Claims 13-14, 17-18, 69-72 and 86-88 are rejected under 35 U.S.C. 102(b) as being anticipated by Antognini et al (US 6176427 B1).

Re claims 13-14, 17-18, 69-72 and 86-88: Antognini et al discloses a symbol generator including: a graphical user interface including a first data input area facilitating entry of a designator for a formatted file (i.e., step 202) (fig. 2; col. 11, lines 20+), and a second data input area facilitating entry of command data (i.e., step 201) (fig. 2; col. 9, line 50 through col. 11, line 19); an encoder (i.e., formatting process 205) encoding into at least one symbol a formatted file in accordance with said designator, and a command in accordance with said input command data (fig. 2; col. 12, lines 53+); wherein said graphical user interface further includes a data input area facilitating input of path data designating a storage location for storing a formatted file onto a portable device (i.e., located in the computer hard disk or from other sources)

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(fig. 2; col. 11, lines 20-30); wherein said graphical user interface further includes a data input area facilitating entry of data indicating whether encoded symbol data is to be compressed (i.e., step 203) (fig. 2; col. 11, line 32 through col. 12, line 53); wherein said graphical user interface further includes a data entry area facilitating entry of data indicating whether encoded symbol data is to be encrypted prior to being encoded into a symbol (fig. 20; col. 43, line 40 through col. 44, line 38); wherein said plurality of viewable files available for encoding are stored at a memory location of a computer that presents said graphical user interface, wherein said encoder encodes a document file, wherein said encoder encodes an image file (fig. 1; col. 9, lines 30-45).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 15-16 and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini et al in view of Hashimoto et al (US 6902114 B2). The teachings of Antognini et al have been discussed above.

Re claims 15-16, 47-54 and 69-72: Antognini et al has been discussed above, but is silent with respect to encode the formatted file into at least one symbol; automatically changes a number of symbols to encode depending; indicate a number of symbols to be encoded; encoding a set of barcodes, a field indicating a total number of symbols of the set, respectively.

Hashimoto et al teaches an encode method and system where the user specifies all setup value; the capacity of the inputted

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data is greater than the predetermined number, the data is encoded into more than one barcode; wherein each of the encoded barcode includes a total number of barcodes making up the setting group and a serial number indicating the order of the barcode in the barcodes making up the setting group (figs. 4-7; col. 8, line 1 through col. 10, line 41).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hashimoto et al into the system as taught by Antognini et al for intended use (i.e., encoding data into barcode symbols). Furthermore, such modification would decrease occurrence of read errors due to the division of data into a plurality of barcodes (i.e., at the scanning time, a distance is kept between the bar code reader and a bar code label, whereby a beam is scattered and thus the scan width widens, but the spot worsens, degrading the read accuracy. Therefore, to ensure precise read, the original data needs to be placed in a proper bar code length), thus providing a more accurate system.

Antognini et al as modified by Hashimoto et al has been discussed above and further discloses the graphical interface may include additional input boxes to allow for input of information with respect to other parameters (col. 8, lines 16-18), but is silent with respect to the user indicating number of

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symbols to be encoded, number of bytes of data into a to-be encoded barcode, and whether a viewable field designated for encoding will be displayed at the time when a symbol encoding the viewable file is read, respectively.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the additional input boxes of Antognini et al/Hashimoto et al to provide the user with the flexibility in selecting desired specific parameters, thus providing a desired encoding result..

8. Claims 73-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antognini et al in view of Barile et al (US 5837986 A). The teachings of Antognini et al have been discussed above.

Re claims 73-85: Antognini et al has been discussed above, but is silent with respect to encoding into the symbol a command which when run by a reader that reads the symbol causes the reader to execute one of a plurality of file opening programs.

Barile et al teaches the reader 3 is programmed/reprogrammed by reading barcode 14 (figs. 1 & 2; col. 8, lines 30+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Barile et al into the system as taught by Antognini



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et al in order to provide Antognini et al with a more versatile system which can be used to reprogram the reader instantaneously and accurately upon scanning the barcode. Furthermore, such modification would have been an obvious engineering variation, well within the ordinary skill in the art, for intended use due to the fact that a barcode can be encoded with any type of information/data, and therefore an obvious expedient.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 13-18, 47-54 and 69-88 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Sun et al (US 5818032 A); Wilz, Sr. et al (US 5992752 A); Petteruti et al (US 6147767 A); Kara (US 6208980 B1); Gulati (US 6525835 B1); Owen (US 7075676 B2) are cited as of interest and illustrates a similar structure to a user interface for an encoding symbol generator.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau

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N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Uyen-Chau N. Le  
Primary Examiner  
Art Unit 2876

November 9, 2006